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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,349	08/23/2005	Watling Jason	322-00089	8333

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

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07/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,349	Applicant(s) JASON ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-25, 27-29 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-25, 28, 29, 32, 33 and 35 is/are rejected.
- 7) ☒ Claim(s) 27 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/28/05, 10/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claim 5 and the claims dependent therefrom are objected to because the variable is defined as having an upper limit of 100% and, in this instance, the polymer would have no pendent crosslinkable groups as claim 1 already requires.

Claims 21 and 34 are objected to because it is, in the Examiner's estimation improper to refer to a structural residue of an assembled polymer as a monomer. Polymers are derived from monomers and, once integrated into the polymer, the residue derived therefrom is more aptly disclosed as being a unit, moiety, etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. .

Claim 25 purports to describe a method of synthesizing the polymer(s) of claim 5 but it appears that the step recited therein only yields a hydrosilyl group-terminated polymer that, perhaps could contain functional groups at the internal repeat units depending upon the identity of the cyclic oligomers. Ostensibly, the reaction is an equilibrium reaction, a common approach for making organohydrogensiloxanes, but the claim likewise, even fails to mention what type of reaction the stated reactants participate in.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 20, 22, 27-29, 33, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Qureshi et al., U.S. patent Application Publication No. 2003/0092866. Qureshi discloses epoxy-functional polysiloxanes adhering to formula (II). See paragraph 18. Of course, given the presence of the epoxy substituents and the resemblance of the overall structure to that of favored embodiments of Applicant's invention, the polymer is inherently crosslinkable under the conditions specified in claims 28 and 29.

Claims 1-5, 7-13, 15-20, 27-29, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lutz et al., U.S. patent # 5,246,979. Columns 3-5, and particularly column 5, lines 12-30, teach acrylamide-functionalized polymers meeting all of the limitations of the aforementioned claims.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7-9, 14-20, 22, 27-29, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qureshi et al., U.S. patent Application Publication No. 2003/0092866. While the Examiner believes the prior art polymer is sufficiently well-defined to merit a 102(e), i.e. it has phenyl group repeating unit content of less than 10%, embraces numerous permutations that would have a molecular weight above 3000 amu, and also many incarnations wherein the variable "n" representing the number of pendent epoxy groups is low, it is acknowledged that the reference may perhaps not disclose all of these requirements simultaneously. At the very least, the teachings of this document render obvious the limitations of the aforementioned claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-13, 15-20, 22-24, 27-29, 32-33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodd et al., U.S. Patent # 6,737,496. Hodd teaches the preparation of polymer materials to be employed as IOLs that adhere to the basic formula set forth in column 4. In addition to having any combination of the repeating units described in the formula and the accompanying definitions, it is said that the polysiloxane will also contain acryl groups at the ends, pendent from the backbone, or both (paragraph bridging column 3 and 4). The polymer of claim 5 is rendered obvious where (i) there exist both terminal and pendent acrylic groups and (ii) units comprising perfluoroalkyl substituents and units comprising aryl groups do not coexist. In the paragraph bridging columns 4 and 5, there is mentioned a polymer adhering to all of the structural requirements of claim 5 with the noted exception that there are no pendent acrylic groups. Nevertheless, such a polymer is rendered obvious in light of the earlier statements that there may be acryl groups at both positions. According to column 5, lines 22-24, the viscosity of the polymer should be between 8000 and 60000 cSt and this viscosity range is consistent with a polymer having a molecular weight within the ranges set out in Applicant's claims. Photopolymerization of this polymer is contemplated elsewhere in the disclosure.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al., U.S. patent # 5,2246,979. Lutz does not explicitly teach a polymer of this molecular weight bearing pendent acrylic groups. There is, however, mentioned a polydimethylsiloxane bearing terminal acrylic groups with a degree of polymerization of

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2000. It is the Examiner's position, therefore, that a polymer having a degree of polymerization similar to that cited herein but having acryl group content consistent with the polymer that follows in column 5 is readily envisaged by the skilled artisan and, thus, claims 23 and 24 are obvious.

Allowable Subject Matter

Claims 27 and 34 appear to be allowable over the prior art were applicant to satisfactorily address the objection to these claims stated earlier.

The ISA cites several documents as being especially relevant to the present claims. The present Examiner agrees that they do, in fact, seem to be germane to at least some of the claims. The Examiner has avoided formally rejecting the claims over these references only in the name of brevity and because they do not seem to be applicable to claims 27 and 34, which are the only claims not rejected over the prior art of record.

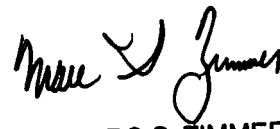
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 11, 2007


MARC S. ZIMMER
PRIMARY EXAMINER